UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,443	08/23/2001	Douglas A. Cheline	PD-201116	2220

20991	7590	05/22/2006

THE DIRECTV GROUP INC
PATENT DOCKET ADMINISTRATION RE/R11/A109
P O BOX 956
EL SEGUNDO, CA 90245-0956

EXAMINER
GAYESKI, MICHAEL R

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/938,443	CHELINE ET AL.
	Examiner	Art Unit	
	Michael R. Gayeski	2143	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on <u>23 February 2006</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   The amendment filed 2/23/2006 had been entered. Claims 1-27 remain pending

in the instant application.

Response to Arguments

2.   Applicant's arguments with respect to claims 1-3, 5-7, 9-11, 13-17, 8, and 20

have been considered but are moot in view of the new ground(s) of rejection.

3.   Applicant's arguments filed 2/23/2006, see "Remarks", pages 12 and 13, with

respect to claims 4, 8, 12, 18-19, and 21-27 have been fully considered but they are not

persuasive.

4.   Applicant argues, in substance, that neither Bendinelli nor Pai suggest that the

gateway could be a modem as recited by the claims. Examiner respectfully disagrees.

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986).

In the instant case, Bendinelli discloses a gateway which is operable to receive

VPN configuration information from a central site (NOC). Bendinelli discloses that, in the

preferred embodiment, the gateway is a general-purpose computer running VPN

software, and is connected an external communications device for connecting to the

NOC (see, *inter alia*, Bendinelli, Paragraphs 117 and 122: 'telephony based network',

i.e. a modem). However, Bendinelli specifically mentions that the gateways may be

implemented on other processing devices, and also mentions that the gateways may be

routers (See Bendinelli, Paragraph 117).

Pai discloses a router with an integrated DSL modem (see, *inter alia*, Pai,

Abstract). The system of Pai includes a CPU and memory for running software

applications, including security applications (see, *inter alia*, Pai, Figure 2 and Column 1,

lines 10-46).

Combining the inventions by implementing the VPN software of Bendinelli on the

integrated router/modem of Pai (i.e. having the gateway(s) **150** of Bendinelli include the

router/modem **R** of Pai) would yield a system wherein software of said modem is

automatically configured with VPN security settings.

Thus, claims 4, 8, 12, 18-19, and 21-27 stand rejected under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

5.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

1.   With regard to **claims 1, 13 and 18**, Bendinelli discloses:

receiving data at a service provider system indicative of a selected server-side

system and a selected client- side system between which a VPN is to be established

(See Figure 4, items 175, 450, and 451; and Paragraphs 0128 – 0130: i.e. the control

system (NOC) serves as a service provider system, the first gateway which initiates the

VPN connection serves as the client system, and the second gateway to which the first

gateway wishes to connect to is the server system);

automatically determining security settings at the service provider system for said

client-side system based at least partially on said data (See Paragraphs 0262, 0263,

and 0270);

and automatically transmitting VPN configuration details from the service

provider system to a modem said client-side system, where said VPN configuration

details include said security settings, such that in use said client-side system is

automatically configured with said VPN configuration details to establish a secure VPN

tunnel between said client-side system and said server-side system (See Paragraphs

0174-0182, 0191 and 0270: The control systems sends the configuration data

necessary to initiate communications with another gateway (server) via a modem).

Bendinelli disclosed the substantive limitations of the base claim. However,

Bendinelli did not specifically disclose that the VPN configuration details are used to

configure said modem (i.e. the VPN software runs on the modem). Rather, the

gateway(s) of Bendinelli comprise a computer device at least capable of running VPN

software, wherein said computer device is connected to an external communications

network (i.e. via a modem, WAN, etc...) (Bendinelli, Paragraphs 117-119).

Bendinelli discloses that the gateways may be any device capable of performing

the functions of the gateway (Paragraph 117), and describes the requirements for such

a device (Paragraphs 118-122). Bendinelli specifically mentions that the gateway device

may include a router (Paragraph 117). Accordingly, one of ordinary skill in the art would be motivated to explore the relevant art for such a suitable device.

Pai, in the analogous art of integrated network routers, teaches a router with an integrated DSL modem. Furthermore, the integrated router and modem of Pai includes an integrated general-purpose CPU and memory for running software, as well as an Ethernet controller (Pai, Abstract; Column 1, line 43-55; Column 2, lines 47-58; and Column 1; Lines 10-46). Combining the inventions by implementing the gateways of Bendinelli in the integrated router/modem of Pai would yield the invention as claimed.

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine the inventions in such a manner, as Bendinelli specifically suggests the gateway may be a router (Bendinelli, Paragraph 117), and the system of Pai teaches such a router which includes an integrated modem, thus providing the advantage of being easier to install than standard routers (Pai, Column 1, lines 34-40).

Thus, claims 1, 13, and 18 are rejected.

2.   With regard to **claims 2 and 14**, the combination of Bendinelli and Pai described immediately above (hereinafter 'Bendinelli-Pai') additionally discloses obtaining data indicative of a selected server in a server side system and a selected user of the client side system from a system administrator, via an electronic network (Bendinelli, Paragraphs 0348 and 0351).

3.   With regard to **claims 3 and 15**, Bendinelli-Pai additionally discloses that said

determining comprises creating a public and private key (Bendinelli, Paragraphs 0334

and 0335).

4.   With regard to **claims 4 and 16**, Bendinelli-Pai discloses the substantive

limitations of the base claims, but does not expressly disclose using a digital certificate

for authentication in the preferred embodiment.

However, Bendinelli does teach that the encryption mechanisms of the preferred

embodiment may be replaced with any suitable authentication method known in the art,

including the use of digital certificates (See Bendinelli, Paragraph 0159). Accordingly, it

would have been obvious to one of ordinary skill in the art to use a digital certificate for

authentication in the system if Bendinelli, with the motivation of allowing the certificate

holder to de-authorize (revoke) a client's authorization.

Thus, claims 4 and 16 are rejected.

5.   With regard to **claims 5, 6 and 17**, Bendinelli-Pai additionally discloses:

        automatically ascertaining further security settings for said server-side system;

and automatically transmitting VPN configuration details to a firewall and VPN

concentrator within said server-side system (Bendinelli, Paragraphs 270-273: The NOC

sends configuration data for both the client-side and server-side VPN concentrators and

firewalls in order to enable communications between the two endpoints).

6.   With regard to **claim 7**, Bendinelli-Pai discloses the use of a modem within a

client side system. Thus, the communications would be sent over the modem

(Bendinelli, Paragraphs 0118 and 0119).

7.   With regard to **claim 8, 19, and 21**, Bendinelli-Pai further discloses said

transmitting comprises communicating said VPN configuration details to a firewall on

said modem within said client-side system (Bendinelli, Paragraphs 174-183 and 273)

8.   With regard to **claim 9**, Bendinelli-Pai further discloses storing data and security

settings (Bendinelli, Paragraphs 264 and 270: i.e. the NOC transmits addresses of new

VPN gateways, which are stored on the gateway).

9.   With regard to **claims 10 and 20**, Bendinelli-Pai further discloses after said

transmitting step, the use of receiving a password from said client-side system, and

authenticating said password (Bendinelli, Paragraph 338: A password, as defined in the

art, is a form of a shared secret).

10.   With regard to **claim 11**, Bendinelli-Pai further discloses establishing a VPN

tunnel between said client-side system and said server-side system (Bendinelli,

Paragraphs 0275 and 0276); and

        verifying that said tunnel is operational (Bendinelli, Paragraph 0278: "the NOC

may monitor the status of the each gateway [...]").

11.   With regard to **claim 12**, the Bendinelli-Pai further discloses a logon page on a

modem within said client-side system (See Pai, Column 4, lines 9-18; and Bendinelli,

Paragraph 0316).

12.   With regard to **claim 22**, it recites similar limitations as claims 1 and 5-9 in a

broader form, and is rejected for similar reasons.

13.   With regard to **claim 23**, Bendinelli-Pai further discloses that the modem is a

DSL modem (See Pai, Abstract).

14.   With regard to **claim 24**, Bendinelli-Pai discloses the substantive limitations of

the base claim, and further teaches that the server system comprises:

        a router configured to electrically coupled to the Internet (See Pai, Figure 2; and

Column 3, lines 13-45);

        a firewall electrically coupled to said router (See Pai, Figure 2; and Column 3,

lines 13-45);

        a file server (See Bendinelli, Paragraphs 0290 and 0291);

        a proxy server (See Bendinelli, Paragraph 0246); and

        Bendinelli-Pai does not explicitly disclose the use of a DNS server within the

server-side system, and instead broadly teaches that the server-side system may

include any number of network services behind the gateway (See Bendinelli, Paragraph

0291). However, the Examiner takes Official Notice that the inclusion of a DNS server on a LAN is old and well-known within the art. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include a DNS server on the local LANs of Bendinelli, with the motivation of providing an operable host naming mechanism, so that users only have to remember short names rather than IP addresses for local services.

Thus, claim 24 is rejected.

15.   With regard to **claim 25**, Bendinelli-Pai also discloses said server-side network further comprises an authentication server for authenticating a user of said client computer (See Bendinelli, Paragraph 0294 and 0295).

16.   With regard to **claim 26**, Bendinelli-Pai also discloses that the service provider comprises:

   a VPN provider (See Bendinelli, Paragraph 0263);

   a DNS server (See Bendinelli, Paragraph 242); and

   an HTTP server (See Bendinelli, Paragraph 0315).

17.   With regard to **claim 27**, Bendinelli-Pai also discloses that the service provider's security generator is a PKI generator (See Bendinelli, Paragraph 270).

Conclusion

18.	The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application Publication 2001/0036192 discloses a system similar to that of Bendinelli, wherein a home gateway device receives VPN configuration details from a modem. Like Bendinelli, the gateway is attached to a separate modem.

19.	Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Gayeski whose telephone number is 571-272-0978. The examiner can normally be reached on M-F: 8:00AM-4:30PM.
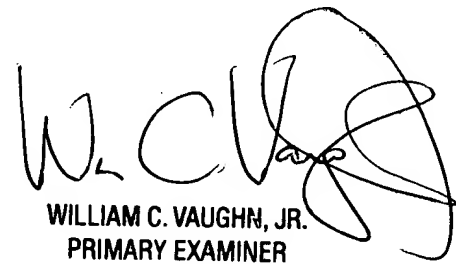
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael R Gayeski
Examiner
Art Unit 2143

mrg
5/10/2006

WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER